

## REMARKS

### **I. Introduction**

Claims 1 to 23 are currently pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1 to 23 Under 35 U.S.C. § 103(a)**

Claims 1 to 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Applicants' alleged admissions (the "background") and James D. Foley et al., Computer Graphics (Addison-Wesley Publishing Company 2d ed. 1990) ("Foley et al."). Without addressing the Office Action's claim interpretations -- and *without* acquiescing thereto -- Applicants respectfully submit that the combination of the background and Foley et al. does not render unpatentable claims 1 to 23 for the following reasons.

As an initial matter, in addressing the merits of this rejection, Applicants do not concede the correctness of the Final Office Action's characterization of the subject matter appearing on page 1 of the Specification as prior art, but will proceed, for the sake of argument only, on the premise that the Final Office Action's characterization is accurate. Therefore, when framed accordingly, the argument of Applicants is that even if the Final Office Action is correct in characterizing page 1 of the Specification as prior art, the subject matter of claims 1 to 23 is still be patentable over such alleged "admissions." It is noted that nowhere does the section of the present application captioned "BACKGROUND INFORMATION" expressly state that anything mentioned therein is in the prior art. That is, the section captioned "BACKGROUND INFORMATION" makes no admissions of prior art. Paragraph 27 of the Final Office Action does not otherwise establish that the statements contained in the section captioned "BACKGROUND INFORMATION" constitutes admissions that those statements constitute prior art. The present rejection appears predicated on the misapprehension of the "BACKGROUND INFORMATION" section of the present application. It is therefore respectfully requested that the present rejection be withdrawn for this reason alone.

Moreover, to establish a *prima facie* case of obviousness, the Office must demonstrate three criteria: (1) there must be some suggestion or motivation to one of ordinary skill in the art to modify a reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when

combined) must teach or suggest each and every limitation in the claim under examination. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Claim 1 relates to a design system for designing new parts in a design-space environment including preexisting parts, and recites, inter alia, a selections device configured to select preexisting parts that overlap and/or border on a design space of a part to be designed. Claim 1 further recites a copying device configured to copy to a CAx system as a design-space environment the selected preexisting parts with data representing a position of the selected parts relative to the design space of the part to be designed. The Final Office Action at paragraph 13 asserts that “the design space (of a part to be designed) appears disclosed by Foley’s page 660 ‘bounding volumes’ and page 664 ‘spacial partitioning.’” However, there is no reference in these sections to a design-space environment formed by selected preexisting parts with data representing a position of the selected parts relative to a design space of a part to be designed. Rather, the sections of Foley et al. referred to by the Final Office Action relate to determining whether objects that have already been designed overlap. If it is determined that they do overlap, they can be redesigned. This raises the problem that objects must be redesigned numerous times until it is determined that the objects do not overlap, a problem addressed by the subject matter of the present application. See, e.g., Response filed August 20, 2004. Nowhere do Foley et al. disclose, or even suggest, copying objects with data representing a position of objects relative to a defined design space for another object that is yet to be designed as a design-space environment. The Final Office Action at paragraph 12 admits that the background does not overcome the deficiencies noted with respect to Foley et al. Accordingly, the combination of the background and Foley et al. does not disclose, or even suggest, all of the features of claim 1. It is therefore respectfully submitted that the combination of the background and Foley et al. does not render unpatentable claim 1.

Claim 11 relates to a method for designing new parts in a design-space environment, and recites, inter alia, displaying preexisting parts in a correct position relative to a design space of a part to be designed as a design-space environment for designing the part to be designed. As set forth above in support of the patentability of claim 1, the combination of the background and Foley et al. does not disclose, or even suggest, at least these features. Since the combination of the background and Foley et al. does not disclose, or even suggest, all of the features of claim 11, it is respectfully submitted that the combination of the background and Foley et al. does not render unpatentable claim 11.

A for claims 2 to 10, which ultimately depend from claim 1 and therefore include all of the limitations of claim 1, it is respectfully submitted that the combination of the background and Foley et al. does not render unpatentable these dependent claims for at least the same reasons set forth above in support of the patentability of claim 1. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

As for claims 12 to 23, which ultimately depend from claim 11 and therefore include all of the limitations of claim 11, it is respectfully submitted that the combination of the background and Foley et al. does not render unpatentable these dependent claims for at least the same reasons set forth above with respect to the patentability of claim 11. *Id.*

### III. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: Feb. 3, 2005

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